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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,336	11/08/2001	Chun-Wei Lin	LIN=176	5199

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,336

Applicant(s)

LIN, CHUN-WEI

Examiner

Lynda M Salvatore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 19 September 2002.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.

5) ☐ Claim(s) 9 and 10 is/are allowed.

6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10 drawn to a fabric structure for making bags, classified in class 442, subclass 62.

~~II. Claims 11-20, drawn to a fabric structure fabrication method, classified in class,~~  
427 subclass 412.

2. The inventions are distinct, each from the other because:

Inventions of Group I and II are related as product and method of making and are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method steps of applying a polymeric layer, bonding with pressure, and applying a surface treatment to a fabric substrate may be employed to fabricate a variety of other composite materials having substrates other than fabric, such as wood, metal, or plastic.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Sheridan Neimark on February 20, 2003 a provisional election was made with traverse to prosecute the invention of fabric structure for making bags, claims 1-10. Affirmation of this election must be made by applicant in replying to

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this Office action. Claims 11-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### *Claim Objections*

7. Claims 5 and 7 are objected to because of the following informalities: Appropriate correction is required.

8. Claims 5 and 7 are objected to because of the awkward claim language of "said surface treating agent containing...material". It is suggested that the claims be amended to read "said surface treating agent *contains* a...material" or "said surface treating agent *comprises* ...material".

#### *Claim Rejections - 35 USC § 112*

9 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10 Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.. Claim 1 is indefinite for the following reasons:

The phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

With regard to the "adapted to" limitations it is unclear to the Examiner what process is performed to produce a fabric sheet, which is "adapted" to be disposed to the outside of the bag to be made.

***Claim Rejections - 35 USC § 102***

11 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12 Claims 1,2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayes, US 2003/0027474 A1.

The published patent application to Hayes discloses a laminated fabric composite suitable for use in the manufacture of automobile air bags (Abstract). The composite consists essentially of a fabric layer having a viscosity increasing coating compound such as alkyl amine, an adhesive layer, a polymeric film layer and a release coating (Section 0058, 0038 and 0065). The polymeric film layer may include styrene-butadiene-styrene block co-polymer (Section

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0038). The release coating layer in this case is considered analogous to the protective coating of the instant invention and is formed from a silicone polyurethane co-polymer (Section 0065).

Hayes also teaches that colorants, dyes, and viscosity control agents may be further added to the fabric, the viscosifier, the adhesive, or the polymeric film (Section 0055).

With regard to the "adapted" to limitations, it has been held that the recitation than an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ

### ***Claim Rejections - 35 USC § 103***

13 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14 Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes US 2003/0027474 A1.

Hayes fails to explicitly teach the claimed materials used for the viscosity layer or a modified styrene block co-polymer surface protective layer, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select known materials for the purpose of increasing viscosity and protection. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ

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15 Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes US 2003/0027474 A1 as applied to claims 1 and 7 above and further in view of Hoey, US Re: 28,682.

Hayes fails to teach adding a pigment to the top release layer, however, Hoey teaches a decorative laminate comprising a textile backing, a thermoset plastic foam bonded thereto, and a transparent polymeric film layer. (Abstract). Hoey teaches that the film can be obtained from crude rubber further comprising butadiene styrene polymers (Column 3, 61-69). Hoey further teaches for specialty effects the films can be colored by pigmenting the liquid prior to casting (Column 3, 45-53). Therefore, motivated to provide a colored release layer comprising butadiene styrene polymers it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the release coating of Hayes with the pigmented styrene butadiene film of Hoey or simply pigment the silicone polyurethane co-polymer containing release layer of Hayes.

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*Allowable Subject Matter*

16 Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, the prior art of Hoey and Hayes fails to teach further adding silicone, isophthalic acid, tetraisopropyl titanate, toluene, and wax to the styrene block co-polymer comprising surface protective layer and presently there is no motivation to combine such references to form and obvious type rejection.

*Conclusion*


17 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

lsj

March 10, 2003

  
CHERYL A. JUSKA  
PRIMARY EXAMINER